

## REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed January 13, 2009 ("Final Office Action"), and the Advisory Action mailed May 29, 2009 ("Advisory Action"). At the time of the Final Office Action, Claims 15-32 were pending in this Application. Claims 15-32 were rejected. Claims 1-14 were previously cancelled without prejudice or disclaimer. Applicant respectfully requests reconsideration and favorable action in this case.

### **Rejections under 35 U.S.C. § 103**

Claims 15-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0016804 by Michael A. Sheha et al. ("Sheha") in view of U.S. Patent Application Publication No. 2004/0203907 by Thomas L. Hiller et al. ("Hiller") and further in view of U.S. Patent Application Publication No. 2005/0141541 by Renaud Cuny et al. ("Cuny").

In a Response to Final Office Action mailed May 13, 2009, Applicant argued that the proposed combinations of *Sheha*, *Hiller*, and *Cuny* are improper. The Examiner responded in the Advisory Action by stating that "[t]hree of Sheha, Hiller, and Cuny deal with the position information of a party may be concurrently delivered to another party's computer terminal and using by Push-to-Talk over cellular (PoC). Three references are in the same class (class 455.) Therefore, there is a strong prima facie case of obviousness to combine the three references." In light of the Examiner's response, Applicant respectfully maintains that the proposed combinations of *Sheha*, *Hiller*, and *Cuny* are improper for the same reasons given in the May 13 Response to Final Office Action, and for the additional reasons discussed below.

First, contrary to the Examiner's conclusion that the three references deal with concurrently delivering position information of a party to another party using PoC, Applicant notes that the Examiner has expressly agreed that neither *Sheha* nor *Hiller* relate to a PoC system. (Final Office Action, Page 3.) In addition, Applicant submits that *Cuny* is silent with respect to position information of a party or the concurrent delivery thereof. Thus, all three

references do not relate to all of the features disclosed in Applicant's invention, as stated by the Examiner. To the extent the Examiner relies on this as providing a basis for combining the references, Applicant requests reconsideration.

Next, the Examiner concludes that because references are in the same class, they are properly combinable. Applicant respectfully disagrees. Under recently decided case law, even if each limitation is disclosed in a combination of references, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Rather (and regardless of whether the references are in the same class), *the Examiner must identify an apparent reason to combine the known elements "in the way the claimed new invention does."* *Id.* Here, the Examiner states that the motivation to combine *Hiller* with *Sheha* is "to be advantageous to subscribers because registered users within the group or fleet that are not in the desired audience group due to geographic location will not be bothered with listening to communications that are not relevant to them." (Final Office Action, Page 3). However, this motivation has nothing to do with adding a pressed talk button to *Sheha*. In fact, this motivation would result in providing less information (i.e., cutting off certain communications) rather than providing more information (i.e., providing the positional information to PoC users in the group). Thus, the Examiner has not identified a legally sufficient reason to combine the elements of *Sheha* with the elements of *Hiller* "in the way the claimed new invention does." *KSR*, 127 S.Ct at 1741.

Finally, because the Examiner maintains that some teaching, suggestion or motivation in the prior art would have led one of ordinary skill in the art to modify and/or combine *Sheha* and *Hiller*, the Examiner must make and articulate each of the following findings:

- a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of skill in the art, to modify the reference or to combine reference teachings;
- a finding that there was reasonable expectation of success; and

- whatever additional findings based on the factual inquiries under *Graham v. John Deere Co.*, 383 U.S. 1 (1966) as may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

The Examiner has failed to make the necessary factual findings, perhaps because there is no documentary evidence of record in the present application to make such a finding. In particular (and as just discussed), the reason for combining the two references has nothing to do with the features of the claimed invention. For example, *Hiller* concerns a half-duplex system (*Hiller* at Abstract ("Voice packets transmitted by an originating wireless user for use in a half-duplex communication mode in a one to many communication session . . .")) while *Sheha* concerns a duplex system (a mobile phone network system). One of ordinary skill in the art would have to use inventive skills to decide which of the two systems, half or full duplex, he would use and how to integrate these two different systems with each other. The Examiner has simply not made a finding with respect to this significant difference between the two references.

The Examiner is respectfully reminded that any findings must be supported by documentary evidence in the record. 37 C.F.R. § 1.104(c)(2); M.P.E.P. § 2144.03(C). The Examiner is also respectfully reminded that if the Examiner relies on personal knowledge to support a finding of what is known in the art, such finding must be supported with an affidavit or declaration setting forth specific factual statements and explanation to support the finding. 37 C.F.R. § 1.104(d)(2); M.P.E.P. § 2144.03(C). In light of the Examiner's failure to establish a *prima facie* case and provide necessary documentary evidence of obviousness, Applicant submits that Claims 15-32 may not be rendered obvious.

For at least the reasons set forth above, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a), and full allowance of Claims 15-32. Applicant reserve the right to make further arguments regarding the Examiner's rejections under 35 U.S.C. § 103(a), if necessary, and does not concede that the Examiner's proposed combinations are proper.

### CONCLUSION

Applicant has made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicant respectfully requests reconsideration of the pending claims.

Applicant encloses a Request for Continued Examination (RCE) and authorizes the Commissioner to charge \$810.00 (RCE fee) and \$1110.00 (Three Month Extension of Time fee) to Deposit Account No. 50-4871 of King & Spalding LLP. Applicant believes no additional fees are due. However, should the Commissioner deem that any additional fees are due, including any fees for additional extensions of time, the Commissioner is hereby authorized to debit such fees from Deposit Account No. 50-4871.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.457.2030.

Respectfully submitted,  
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